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November 12, 1999

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Assistant Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Application
Appl. No. 09/126,945; Filed: July 31, 1998
For: **Prostate Derived Ets Factor**
Inventors: LIBERMANN *et al.*
Our Ref: 1488.1090000/EKS/GLL

Sir:

In reply to the Office Action mailed October 12, 1999, transmitted herewith for appropriate action are the following documents:

1. Election and Response with Traverse Under 37 C.F.R. § 1.143; and

2. One return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Eric K. Steffe
Attorney for Applicants
Registration No. 36,688

EKS/GLL/eak

Enclosures

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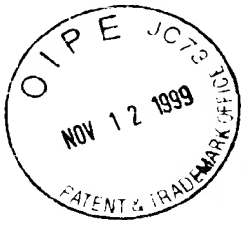
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:
LIBERMANN *et al.*
Appl. No. 09/126,945
Filed: July 31, 1998
For: **Prostate Derived Ets Factor**

Art Unit: 1632
Examiner: Priebe, S.
Atty. Docket: 1488.1090000/EKS/GLL

Election and Response with Traverse Under 37 C.F.R. § 1.143

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed **October 12, 1999** (PTO Prosecution File Wrapper Paper No. 7), Applicants provisionally elect, *with traverse*, Group I, represented by claims 1-10, 17 (second part) and 21, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to the non-elected inventions should the restriction requirement be made final.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

The Restriction Requirement

The Examiner has restricted the originally filed claims into the following groups:

I. Claims 1-10, 17 (second part) and 21, drawn to human polynucleotides and method using same in treatment, classified in class 536, subclass 23.5; class 435, subclasses 320.1 and 325; class 514, subclass 44;

II. Claims 11-12 and 14-16, drawn to polypeptides and method for making same from cultured cells, classified in class 435, subclass 70.1; class 530, subclass 350;

III. Claims 13 and 19, drawn to an antibody and method of using same to identify a polypeptide, classified in class 530, subclass 387.1; class 435, subclass 7.21;

IV. Claim 17 (first part), drawn to a method of treatment with a protein, classified in class 514, subclass 2;

V. Claim 18, drawn to a method for detecting mutation in polynucleotide, classified in class 435, subclass 6;

VI. Claim 20, drawn to a method for identifying a ligand of a polypeptide, classified in class 435, subclass 7.1; and

VII. Claim 22, drawn to a method for identifying a biological activity, classified in class 435, subclass 455.

The Examiner indicated that claim 23 was not classified in any group and is withdrawn from consideration.

Applicants respectfully traverse the restriction requirement as it applies to Groups I and II. It is the Examiner's position that nucleic acids and the encoded proteins are patentably distinct molecules because they require different products for their practice, involve different process steps and have different goals or outcomes. (Paper No. 7 at page 3.)

Even where two patentably distinct inventions appear in a single application, restriction remains improper unless the Examiner can show that the search and examination of both groups would entail a "serious burden." (*See* MPEP § 803.) In the present situation, the Examiner has clearly failed to make such a showing.

Applicants submit that a search of the polynucleotide claims would clearly provide useful information for the polypeptide claims. This is because the genetic code is known. Moreover, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence. Thus, the searches for polynucleotides and polypeptides would clearly be overlapping.

Accordingly, as applied to Groups I and II, the restriction requirement should be withdrawn.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Eric K. Steffe
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Registration No. 36,688

Date: November 12, 1999

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